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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,406	11/28/2003	Miyuki Tanaka	245996US0	7403
22850	7590	05/03/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			PENG, KUO LIANG	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1712

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,406

Applicant(s)

TANAKA ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/7/04 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/04, 1/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Okami (US 5 104 919).

Okami discloses a flame retardant silicone composition comprising components A) to E). Component E) can be triazole compounds described in col. 5, lines 15-53.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Enami (EP 732 373).

Enami discloses a flame retardant silicone composition comprising components A) to D). (page 2, line 20 to page 3, line 36) The amount of

Art Unit: 1712

cyclic diorganosiloxane is no more than 0.1 wt%. (page 2, lines 36-52)

Component C) can be triazole compounds as described in page 3, lines 8-29.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki (US 5 516 838) in view of Okami.

Fujiki discloses a flame retardant silicone composition comprising components A) to D). The composition contains non-functional low-molecular weight siloxanes D3 to D10 in an amount of less than about 1,000 ppm. (col. 1, line 45 to col. 2, line 11 and Examples) Component D) (such as benzotriazoles, etc.) can be present in an amount of about 0.01 to about 1 part. (col. 3, line 54 to col. 4, line 14) Fujiki is silent on the specific compound D) set forth in the present invention. However, Okami teaches

Art Unit: 1712

that benzotriazole and other triazoles such as 1,2,3-triazole, etc. can be used interchangeably and equivalently in a flame retardant silicone composition similar to Fujiki's composition. The motivation is to afford a composition with flame retardance, low permanent compression set, etc. (col. 5, lines 15-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate Okami's 1,2,3-triazole, etc. into Fujiki's composition with expected success. See MPEP 2144.06.

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki (US 5 516 838) in view of Enami.

Fujiki discloses a flame retardant silicone composition comprising components A) to D). The composition contains non-functional low-molecular weight siloxanes D3 to D10 in an amount of less than about 1,000 ppm. (col. 1, line 45 to col. 2, line 11 and Examples) Component D) (such as benzotriazoles, etc.) can be present in an amount of about 0.01 to about 1 part. (col. 3, line 54 to col. 4, line 14) Fujiki is silent on the specific compound D) set forth in the present invention. However, Enami teaches that benzotriazole and other triazoles such as 1,2,3-triazole, etc. can be used interchangeably and equivalently in a flame retardant silicone composition

Art Unit: 1712

similar to Fujiki's composition. (page 3, lines 8-25) The motivation is to afford a composition with flame retardance, etc. (page 2, lines 3-4).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to incorporate Enami's 1,2,3-triazole, etc. into Fujiki's composition with expected success. See MPEP 2144.06.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

Art Unit: 1712

to the Private PAIR system, contact the Electronic Business Center (EBC) at
866-217-9197 (toll-free).

klp
April 25, 2006



Kuo-Liang Peng
Primary Examiner
Art Unit 1712